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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

3507.2.27

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on Feb. 10, 2006

Signature E. R. Witt

Typed or printed name Evan R. Witt

Application Number

10/735,322

Filed

12/12/2003

First Named Inventor

Chih-Lung Chang

Art Unit

1734

Examiner

Sue A. Purvis

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record. 32,512  
Registration number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

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Telephone number

February 10, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/735,322 Confirmation No.: 6011  
Applicant : Chih-Lung Chang et al.  
Title : IMAGE TRANSFER MEDIUM AND  
PROCESS FOR PRODUCING SAME  
Filed : December 12, 2003  
TC/A.U. : 1734  
Examiner : Sue A. Purvis  
Docket No. : 3507.2.27

**REMARKS/ARGUMENTS SUPPORTING APPLICANTS'**  
**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

This paper is submitted in response to the Advisory Action mailed January 20, 2006. In the Advisory Action, the Examiner did not find Applicants' arguments persuasive and maintained the prior rejection of claims 1-3 under 35 U.S.C. §103(a) as being obvious over the Admitted Prior Art (hereinafter "the APA") in view of U.S. Patent No. 6,491,781 to Kreckel et al. (hereinafter "Kreckel") and U.S. Patent No. 6,610,386 to Williams et al. (hereinafter "Williams").

Applicants respectfully assert that the Examiner clearly erred in maintaining the rejection of claims 1-3 under 35 U.S.C. § 103 because the Examiner had not established *prima facie* obviousness.<sup>1</sup> The Examiner failed to establish *prima facie* obviousness because (1) the Examiner did not provide any motivation to combine the APA with Kreckel and Williams; (2) the APA, Kreckel, and Williams, either singly or in combination, do not disclose, teach, or suggest all of the elements of claims 1-3; and (3) combining the APA with Kreckel and Williams would render the APA and Williams unsatisfactory for their intended purposes.

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<sup>1</sup> In the Advisory Action the Examiner's only assertion, other than that Applicants' arguments "were not found to be persuasive," was that the Examiner "did not misstate the test for obviousness" and referred to M.P.E.P. § 2145. Applicants submit that the Examiner may have properly quoted *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). However, Applicants respectfully submit that the quote from *In re Keller* is not the proper test for establishing a *prima facie* case of obviousness. Rather, the proper test is the test presented in M.P.E.P. § 2143. Additionally, though M.P.E.P. § 2145 quotes *In re Keller*, the italicized portion of the case quoted by the Examiner is not included in the M.P.E.P. See Applicants' Response to Final Office Action, page 2. Applicants submit that the *In re Keller* quote is not the test for establishing a *prima facie* case of obviousness. Rather, the M.P.E.P. cites *In re Keller* for the proposition that prior art references need not be physically combinable. Therefore, the Examiner failed to state and apply the proper test for obviousness, a clear legal error.

I. THE EXAMINER DID NOT PROVIDE ANY MOTIVATION TO COMBINE THE CITED REFERENCES

The Examiner did not provide any motivation to combine the APA with Kreckel and Williams. *See* M.P.E.P. §2143.01(III). Rather, the Examiner merely asserted that “It would have been obvious to one having ordinary skill in the art at the time the invention was made based on the teachings of Kreckel to use the transferable medium disclosed in the admitted prior art on an article with a light transmissible surface.” Final Office Action, page 2, *See also id.* at page 3 and Non-Final Office Action mailed June 1, 2005, page 3. Nowhere in the Office Actions does the Examiner provide any motivation to combine these references. Because the Examiner did not provide any motivation to combine the cited references, the Examiner clearly erred in maintaining the rejection of claims 1-3 under 35 U.S.C. § 103.

II. THE CITED REFERENCES DO NOT DISCLOSE, TEACH, OR SUGGEST ALL THE CLAIMED LIMITATIONS

Independent claim 1 recites “removing a selected portion of said transferable material to obtain a hollowed transferable material with a specific pattern vacancy; and adhering the remaining transferable material onto said light transmissible surface of said article, thereby allowing light emitted by said light source to penetrate through the specific pattern vacancy.” Claims 2 and 3 depend from claim 1 and thus, also include these claim elements. Applicants respectfully submit that neither the APA, Kreckel, nor Williams disclose, teach, or suggest these limitations.

The Examiner asserts that “when a word such as “PRIMAX” is transferred to an article, a hollowed transferable material is created with a specific pattern [vacancy].” Final Office Action, page 2. Even assuming, for the sake of argument, that the APA teaches “removing a selected portion of said transferable material to obtain a hollowed transferable material with a specific pattern vacancy,” the Examiner has not cited, nor can Applicants find any portion of the cited references that discloses “adhering the remaining transferable material onto said light transmissible surface of said article, thereby allowing light emitted by said light source to penetrate through the specific pattern vacancy,” as recited in claim 1.

The Examiner admitted, and Applicants agree, that the APA “does not teach transferring onto a light transmissible surface as required by the claim.” However, the Examiner also asserts that “Kreckel teaches that transferring an image graphic onto an article having a light

transmissible surface is known.” Final Office Action, page 2. Applicants submit that “transferring onto a light transmissible surface” is only a small portion of the entire “adhering” claim limitation, as recited in claim 1. Additionally, though Kreckel may disclose “transferring an image graphic onto an article having a light transmissible surface,” Kreckel does not disclose “adhering the remaining transferable material [after removing a selected portion of said transferable material] onto said light transmissible surface of said article, thereby allowing light emitted by said light source to penetrate through the specific pattern vacancy,” as recited in claim 1.

The Examiner cited to the following portion of Kreckel as teaching “transferring onto a light transmissible surface,”

In a preferred embodiment of the present invention, the substrate is a front panel of a backlit light display. Thus, the present invention provides a system for displaying an image using a reusable adhesive under the demanding conditions of images that are illuminated from behind the image and through the adhesive.

Kreckel, col. 8, lines 28-33 (emphasis added). Kreckel does not disclose “allowing light to penetrate through a specific pattern vacancy,” as recited in claim 1. Rather, this portion discloses that the light passes “through the adhesive” not through the specific pattern vacancy.

The Examiner is referred to Fig. 2 of the present invention. When a selected portion of the transferable material (ink layer 321) is removed to obtain a hollowed transferable material, the corresponding portion of adhesive layer 323 is also removed. Hence, the “specific pattern vacancy” does not have a corresponding adhesive layer and the image is not illuminated “through the adhesive” as suggested by Kreckel. Therefore, Kreckel does not disclose, teach, or suggest “adhering the remaining transferable material onto said light transmissible surface of said article, thereby allowing light emitted by said light source to penetrate through the specific pattern vacancy,” as recited in claim 1.

Likewise, the Examiner has not cited nor can Applicants find any portion of Williams that discloses, teaches, or suggests the “adhering” claim limitation, as recited in claim 1.

Therefore, neither the APA nor the cited references disclose, teach, or suggest “adhering the remaining transferable material onto said light transmissible surface of said article, thereby allowing light emitted by said light source to penetrate through the specific pattern vacancy,” as recited in claim 1.

Thus, the APA in view of Kreckel and Williams does not disclose, teach, or suggest all the elements of claims 1-3. The Examiner has failed to establish the *prima facie* obviousness of claims 1-3. Consequently, the Examiner clearly erred in maintaining the rejection of these claims under 35 U.S.C. § 103.

III. THE EXAMINER DID NOT PROVIDE ANY MOTIVATION TO COMBINE THE CITED REFERENCES BECAUSE COMBINING THE APA AND WILLIAMS WOULD RENDER BOTH REFERENCES UNSATISFACTORY FOR THEIR INTENDED PURPOSES

Applicants submit that the Examiner did not provide any motivation to combine the cited references because combining the APA and the Williams reference would render both references unsatisfactory for their intended purpose. *See* M.P.E.P. §§ 2143.01(V) and 2143.01(VI).

The intended purpose of the APA is to remove selected letters, printed in advance, from the transferable medium to spell words. *See* Specification, paragraph [0004]. The intended purpose of Williams is to print a data dot code or two-dimensional bar code that “is capable of being read by a sensor.” Williams, Abstract.

However, if any part of the APA’s “predetermined image” or Williams’ dot code or two-dimensional bar code were removed, as suggested by the Examiner, neither the removed transferable material nor the remaining transferable material would be the “predetermined image” or contain the data “capable of being read by a sensor.” Instead, the removed and remaining transferable material would no longer be the “predetermined image” or be “capable of being read by a sensor” rendering the references unsatisfactory for their intended purposes and therefore rebutting any motivation to combine these references. Consequently, it is clear error to maintain the rejection of claims 1-3 based on the combination of the APA and Williams as suggested by the Examiner.


IV. CONCLUSION

Because the Examiner did not provide any motivation to combine the APA with Kreckel and Williams, because neither the APA, Kreckel, nor Williams, singly or in combination, discloses, teaches, or suggests all the elements of claims 1-3, and because the combination of the APA and Williams would render both references unsatisfactory for their intended purposes, the Examiner has failed to establish *prima facie* obviousness against claims 1-3. Therefore, the Examiner clearly erred in maintaining the rejection of claims 1-3 under 35 U.S.C. § 103.

Appl. No. 10/735,322  
Pre-Appeal Brief Request for Review

Consequently, Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "E. R. Witt", is written over a horizontal line.

Evan R. Witt  
Reg. No. 32,512  
Attorney for Applicants